

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHRISTOPHER JOHN STEVENS

Appeal No. 2001-0074
Application 09/039,829

ON BRIEF

Before DELMENDO, JEFFREY T. SMITH, and MOORE, Administrative Patent Judges.
MOORE, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from a final rejection of claims 1, 2, 4, 5, 6, and 7, all of the claims pending in this application. Claim 3 has been cancelled.

CLAIMS

Claim 1 is representative of the claims on appeal, and reads as follows:

1. A tape dispenser comprising a handle within which are means for storing a supply of tape including a backing ribbon carrying a coating composition, and the backing ribbon from which the coating composition has been removed, and an applicator with an edge around which the tape passes and arranged for pressing the tape against a surface to transfer the coating composition from the backing ribbon to said surface, the handle being coupled to the applicator to permit selective adjustment of the handle relative to the applicator edge between positions inclined in opposite

directions with respect to a plane normal to the edge, wherein detent means are provided for retaining the handle in the selected adjustment position.

THE REFERENCES

In rejecting the appealed claims under 35 U.S.C. §103, the Examiner relies on the following references:

Klugmann	2,750,616	Jun. 19, 1956
Bryant et al. (Bryant)	5,038,492	Aug. 13, 1991
Stevens (British Patent Application)	2,275,042A	Aug. 17, 1994

THE REJECTIONS

Claims 1 -2 and 4-7 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Claims 1-2 and 4-7 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Stevens in view of Bryant and Klugmann.

DISCUSSION

The Invention

The Appellant's invention relates to a tape dispenser having a handle within which is a tape supply. The tape supply includes a backing ribbon and a coating composition. The tape passes around an edge when in use, depositing the coating composition when the edge is pressed upon a surface. The handle is coupled to the

applicator to permit selective adjustment in inclinations. (Appeal Brief, page 1, line 18 - page 2, line 8).

The Section 112 Rejection

Claims 1-2 and 4-7 stand rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

The record indicates that Claim 1 has been amended to recite that the tape “includes” a backing ribbon and a coating composition. (Amendment of October 25, 1998, page 1; Paper #9). Claim 1 as filed recites that the tape “consists of” a backing ribbon and a coating composition. (Specification, page 7, lines 3-4). The specification recites throughout that the tape “consists of” a backing ribbon and a coating composition (Examiner’s Answer, page 3, lines 1-3; see Specification, page 2, line 16; page 5, lines 10-12). These facts are not in question.

The Examiner concludes that one reading the originally filed application where consisting of is used throughout would not think that Applicant intended other items to be part of the tape. (Examiner’s Answer, page 3, lines 5-7).

The Appellant, on the other hand, states that nowhere in his application does it recite “that the tape could not include other items besides ‘a backing ribbon carrying a coating composition, and the backing ribbon from which the coating composition has been removed.’” (Appeal Brief, page 3, lines 10-12). Therefore, he reasons, even if the amendment broadens claim 1, no new matter is added.

As no separate argument is provided for any dependent claim, all claims stand or fall with claim 1 for purposes of this rejection. See 37 CFR §1.192(c)(7)(1999).

Analysis

This set of facts requires us to determine two issues: 1) the scope of the claims, and 2) the sufficiency of the disclosure in supporting those claims. To do this, we must wear two different hats. The scope of the claim language is an issue of law, to be decided according to the appropriate tenets of claim construction which are well-known to patent practitioners. See Markman v. Westview Instruments, Inc., 52 F.3d 967, 34 USPQ2d 1321 (Fed. Cir. 1995) (en banc). However, the issue of the sufficiency of the written description is an issue of fact, to be analyzed according to the knowledge of that yet again elusive hypothetical person of ordinary skill in the art. Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991). We address the issue of claim construction first.

The issue of whether “including” is open-ended, like “comprising,” or means something else, like “consisting essentially of” or “consisting”, is a matter evaluated on a case-by-case basis. Cf. the discussion under OTHER TRANSITIONAL PHRASES in § 2111.03 of the Manual of Patent Examining Procedure (discussing prior court interpretations of “having” and “composed of”). See also Crystal Semiconductor Corp. v. Tritech Microelectronics International, Inc., 246 F.3d 1336, 1348 (Fed. Cir. 2001) (“having” does not create a presumption that the body of the claim is open; rather the claim must be examined in its full context to determine whether “having” limits the claims to its recited elements); AFG Industries, Inc. v. Cardinal IG Co., Inc., 239 F.3d

1239, 1245, 57 USPQ2d 1776, 1780 (Fed. Cir. 2001) ("composed of" in this case was interpreted to be the same as "consisting essentially of").

In this case, both the Appellant and the Examiner are in agreement that "including" is open ended, like "comprising." We concur. "Including" allows the tape element of the claim to contain additional items which may or may not materially affect the claimed subject matter. Further, the entire claim is constructed with "comprising" in the preamble, which overall leaves the claim open to inclusion of nonrecited elements. Thus, the issue is one of whether the specification supports such an amended claim.

The adequate written description requirement of 35 U.S.C. Section 112 provides that:

[t]he specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

As noted above, an issue arising under the written description requirement of 35 U.S.C. § 112, first paragraph, is a question of fact. Vas-Cath, 935 F.2d 1563, 19 USPQ2d 1116.

The adequate written description requirement, which is distinct from the enablement and best mode requirements, serves "to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him; how the specification accomplishes this is not material." In re Wertheim, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). In order to meet the adequate written description requirement, the applicant does not have to utilize any particular form of disclosure to describe the subject matter claimed, but "the description

must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." In re Gosteli, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989). Put another way, "the applicant must . . . convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention." Vas-Cath, 935 F.2d at 1563-64, 19 USPQ2d at 1117.

Finally, "[p]recisely how close the original description must come to comply with the description requirement of section 112 must be determined on a case-by-case basis." Eiselstein v. Frank, 52 F.3d 1035, 1039, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995) (quoting Vas-Cath, 935 F.2d at 1561, 19 USPQ2d at 1116).

In the present instance, a thorough review of the specification reveals to us that the term "consisting of" is used consistently throughout the specification. But the question of what "consisting of" means in the specification is slightly different from what "consisting of" means in the claims. We must consider whether "consisting of," to one of ordinary skill in the art of tape dispensers for applying a coating to a surface, would close the invention to additional elements.

We note that nowhere in the specification is found a disclosure of additional elements. No further layers are taught, and our review of Figures 3 and 4 indicates that, indeed, inclusion of an additional layer or other item beyond the coating and the carrier film could interfere with the functioning of the coating. The function is discussed at page 1, lines 15-26, and it is clear that the coating composition is stripped away from the backing ribbon to adhere to the paper surface.

Accordingly, we find that one of ordinary skill in the art would find the term "consisting of" in the specification as it applies to the tape structure to be closed to the

addition of other elements which materially affect this function. Therefore, we agree with the Examiner's conclusion that Claim 1 does not comply with 35 U.S.C. §112, first paragraph, as the as-filed specification does not provide adequate written descriptive support for this claim.

We, therefore, affirm this rejection.

The Section 103 Rejection

Claims 1-2 and 4-7 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Stevens in view of Bryant and Klugmann.

The Examiner has found that Stevens teaches all of the claimed elements except for:

(a) handle 1 being coupled to applicator 5 to permit selective adjustment of handle 1 relative to edge 6 between positions in opposite directions with respect to a plane normal to edge 6; and

(b) a detent means to hold handle 1 in a selected position. (Examiner's Answer, page 3, lines 10-19).

The Examiner has found that Bryant teaches a handle attached to an applicator within which is a supply of tape and a surface, arranged for pressing tape against a surface to apply the tape. The Examiner has further found that the handle is coupled to the applicator to permit selective pivotal adjustment of the handle about a point relative to the surface of roll between positions included in opposite directions with respect to a plane normal to the surface of roll. The handle has a lock to retain the handle in the selected position. (Examiner's Answer, page 3, lines 20-26).

The Examiner thus concludes it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Stevens a handle coupled to the applicator to permit selective adjustment of the handle about a point relative to the edge because Bryant teaches that such allows the user to rotate the handle to any necessary position. (Examiner's Answer, page 3, line 26 – page 4, line 4).

Klugmann is relied upon for the teaching of a pivoting handle at a point 16 relative to brush 14 attached to head 11 using disks 17 and 18 of head 11 in combination with item 21 of handle 12. Handle 12 is retained in a selected position using a detent means formed by cooperating ridges and depressions between disk 17 and item 21. Detent means holds handle 12 and head 11 firmly in position after rotation. (Examiner's Answer, page 4, lines 8-13).

The Appellant does not challenge the disclosures of the references, nor the propriety of the combination. Instead, he argues that the problem faced by the inventor was the creation of a tape dispenser which could be used conveniently by both right and left handed people and therefore Klugmann, being omni-directional in use, is not reasonably pertinent to the left-hand, right-hand problem. Without Klugmann (as non-analogous art), it is reasoned, no prima facie case of obviousness exists. (Appeal Brief, page 3, line 28 - page 4, line 11).

As we agree with the Appellant that no prima facie case of obviousness exists, we will reverse the Examiner's rejection.

We agree with the Examiner that Stevens discloses a handle containing a spool of backing ribbon having a coating composition thereon and a takeup spool displaced longitudinally. A length of tape is guided using posts and slots to pass around the tip edge. (Stevens, page 5, lines 9 – 30).

Where we part company with the Examiner is in our interpretation of the Bryant reference. The adjustable pivot of Bryant is applied at the handle end of the device, between the handle and the applicator portion containing the tape reel and tip. The handle is adjustable and lockable. (See Bryant, Fig. 1)

Claim 1 of the instant application is very specific about the structure of the handle. The handle contains the means for storing a supply of tape. The handle, containing this tape, is then coupled to the applicator to permit selective adjustment of the handle relative to the applicator edge. In other words, the pivot point is also between the “handle” and the applicator. However, the mechanism of the tape reels is contained in the handle and the adjustment must also therefore occur between this mechanism and the tip.

Bryant’s “handle” does not contain the tape reel, rather this mechanism is included in the head of the device. (See Figs. 1, 3, 14, 15). Bryant’s pivot adjusts the handle relative to the applicator, but with the dispensing apparatus on the applicator side of the pivot. Thus, one of skill in the art, if they were motivated to combine Stevens and Bryant, could simply extend the handle of Stevens and add an adjustable handle beyond the current handle, and/or move the tape dispensing apparatus closer to the head of the device.

We do not see the motivation for placing the pivot point of the instantly claimed invention between the handle (which must contain the tape reels) and the applicator tip. This claimed arrangement would appear to add substantially to the complexity of the device and raise issues regarding providing the tape from the reels to the tip, when such could be avoided by keeping the reels closer to the tip and placing an adjustable handle outside the tape supply.

While we agree that Bryant does disclose the inclusion of an adjustable handle to allow rotation of the handle to any necessary position (Examiner's Answer, page 4, lines 1-1), this reference does not show the location of the pivot point between the tape dispenser and the applicator edge.

Accordingly, as a prima facie case of obviousness has not been established, we shall reverse this rejection. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

SUMMARY OF DECISION

The rejection of claims 1-2 and 4-7 under 35 U.S.C. §112, first paragraph, is sustained.

The rejection of claims 1-2 and 4-7 under 35 USC §103(a) is reversed.

TIME PERIOD FOR RESPONSE

No time period for taking any subsequent action in connection with this appeal
may be extended under 37 CFR 1.136(a).

AFFIRMED

ROMULO H. DELMENDO
Administrative Patent Judge

JEFFREY T. SMITH
Administrative Patent Judge

JAMES T. MOORE
Administrative Patent Judge

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